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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/777,492
Filing Date: February 05, 2001
Appellant(s): BOVE ET AL.

Mark C. Young
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 15, 2008 appealing from the Office action mailed June 18, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,574,608	DAHOD ET AL.	6-2003
5,794,207	WALKER ET AL.	8-1998
6,839,680	LIU ET AL.	1-2005

2002/0169626	WALKER ET AL.	11-2002
6,662,199	FLIGHT ET AL.	12-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3, 5-9, 10, 12-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahod et al. (US Patent 6,574,608 B1, hereafter Dahood) in view of Wilkins et al. (US Patent 6,868,389 B1, hereafter Wilkins).

Re. Claims 1, 9 & 16, Dahod discloses a computer-implemented method, system and a computer readable medium for generating anonymous leads from anonymously submitted database search criteria (BUYER ANONYMITY: Buyers are able to control whether and how personal information on the buyer is revealed to a given seller - Col. 2, ll. 27-29, 50-52, 55-56; Col. 3, ll. 4-6; Claims 34 & 63 – Col. 9, l. 18; Col. 11, l. 4), comprising:

- maintaining a prospect database (col. 2, 32-40; col. 5, ll. 18-20) identifying corresponding prospect information comprising:
 - (i) prospect-identifying information, and
 - (ii) anonymously submitted search criteria
 - (iii) search information corresponding to said search criteria.(col. 4, ll. 24-28;)
- transmitting said prospect information to a business expert in a prospect

presentation, wherein the prospect presentation is designed to enable generation of a proposal, and wherein the prospect information does not include the device-identifying information from a prospect (Col. 2, ll. 22-40. Providing information desired by a seller or accessed by a seller from a web site involves an electronic transmission of the information); and

- transmitting proposals to a device associated with the prospect for which the proposal is generated (Col. 2, ll. 38-42).

Dahod does not explicitly disclose a database which stores device identifying information. These are obviously residing in the middle man facilitator's server data base. An ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious that Dahod's teaching suggests retention by the middle man server of the device identifying information of both buyers and sellers since that information is presented to the server through the network as part of the connection. The middle man obviously can, and would have to collect that information in order to be able to communicate with either type of device, such as communicating prospect information to a business expert. The fact that Dahod suggests or even requires registration for buyers would have been an incidental piece of information to the ordinary practitioner of the art because of what he would have known about electronic networks such as the internet. The electronic device identifying information would in any case be available for equipping a seller to communicate to an anonymous buyer prospect. The facilitating middle man would have high motivation to retain this electronic information automatically for all buyers and sellers who contact his system. This has been done routinely over the internet for many years, with many web site operators automatically saving such information and planting cookies in the devices of those who access their sites. For example, Wilkins discloses the use of cookies for these purposes (Col. 2, ll. 26-43). So neither buyers nor sellers would or could obviously be truly unknown to the middle man facilitator since the facilitator's system had, could have or should have saved that automatically presented information in the respective database files of the participating parties. That information would still maintain the anonymity of the humans involved subject to their voluntarily disclosing that personal information, but all that is

needed for operating the method and system is the device information. Therefore, it would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Dahod with those of Wilkins to design a method, system and a computer readable medium for generating anonymous leads from anonymously submitted database search criteria. The motivation for combining Dahod's and Wilkins' information with the information already known by the ordinary practitioner is to connect prospective buyers and sellers with each other more easily, efficiently and inexpensively (Dahod, Col. 1, ll. 59-63).

Re. Claim 3, Dahod discloses a method wherein the prospect database identifies prospect information for a plurality of prospects, all of which are active (Dahod discloses making a plurality of qualified buyer prospects available to sellers because a qualified buyer is a prospect in the world of selling since qualifying is a critical step in the selling process. One parameter of qualifying a sales prospect is that the prospect demonstrates an active desire to buy, which is not required to be a guarantee to ultimately buy. Col. 2, ll. 49-51).

Re. Claim 5, Dahod discloses a computer-implemented method wherein the prospect has no explicit gateway available (The non-gateway option is assumable through the "if" option; Col's 1-12).

Re. Claims 6 & 19, neither Dahod nor Wilkins explicitly disclose a computer-implemented method and computer readable medium wherein the transmitting proposal step comprises:

- (a) receiving a request for a formatted set of data, wherein the request includes a device identifier;
- (b) checking a status indicator to determine whether a proposal should be provided;
- (c) adding a proposal notification to the requested formatted set of data, if the checking step results in a determination that a proposal should be provided; and
- (d) transmitting the formatted set of data.

Please see the rejection rationale of claim 1. The examiner gives Official Notice that this illustrates that these steps were well known in the art of programming computers to achieve communications compatibility between parties so that the receiving party is able to parse a communication from another party. The proposal notification is optional, therefore is not required. Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have been able to combine the art of Dahod and Wilkins with Official Notice of well known programming techniques, motivated by the purpose of easily, efficiently and inexpensively connecting prospective buyers of goods and services with qualified sellers (Dahod, Col. 1, ll. 60-63).

Re. Claim 7, Dahod discloses a method wherein the proposal notification provides a link to a proposal-viewer, which enables anonymous communication between the device user and the business expert (Fig. 11; Col. 3, ll. 54-55).

Re. Claims 8 & 20, Dahod discloses a method and computer readable medium wherein the status indicator is included in the request, and wherein the formatted set of data comprises a web page (Col. 4, ll. 40-46), the prospect presentation comprises one or more web pages (Fig. 11), the proposal-viewer comprises one or more web pages (Fig's 11&12),

Neither Dahod nor Wilkins explicitly disclose that the device identifier comprises a cookie, the status indicator comprises a cookie and the prospect comprises an XML data. However, the examiner gives Official Notice that a cookie used as a device identifier and as a status indicator, and that XML data sets were well know in the art at the time of Applicant's invention. Accordingly, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have added the well known Official Notice devices of cookies and XML data sets to the art of Dahod and Wilkins, motivated by the purpose of easily, efficiently and inexpensively connecting prospective buyers of goods and services with qualified sellers (Dahod, Col. 1, ll. 60-63).

Re. Claim 10, Dahod discloses a computer system comprising a business database (Fig. 7).

Re. Claims 12 & 18, neither Dahod nor Wilkins explicitly disclose a computer system and computer readable medium wherein the server engine is configured to not provide

anonymous leads derived from particular prospects to particular business experts based upon gateway information for the particular prospects and gateway affiliation information for the particular business experts. However, please see the rejection logic presented for claims 1, 9 and 16 above. The ordinary practitioner at the time of Applicant's invention would have known that gateways are devices used to connect networks using different communications protocols so that information can be passed from one to another. As such, gateway information for the prospects and the business experts who contact the facilitator's web site is automatically presented to the facilitator for use in accomplishing his purposes. It was thus unnecessary for Dahod to explicitly disclose this information. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the teaching of Dahod and Wilkins and the practitioner's own information in a system which maintains the anonymity of the user-prospect until the user authorizes the release of various aspects of his information as part of an anonymous system for easily, efficiently and inexpensively connecting prospective buyers of goods and services with qualified sellers, motivated by the desire to easily, efficiently and inexpensively connecting prospective buyers of goods and services with qualified sellers (Dahod, Col. 1, ll. 60-63). .

Re. Claim 13, neither Dahod nor Wilkins explicitly disclose a computer system wherein the server engine is configured to furnish the proposals by selective use of session identifiers and device identifiers. However, the examiner takes Official Notice that the use of session and device identifiers was well known in the art at the time of Applicant's invention. Consequently, it would have been obvious for an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Dahod and Wilkins with the selective use of session and device identifiers in furnishing proposals to user prospects as part of an anonymous system for easily, efficiently and inexpensively connecting prospective buyers of goods and services with qualified sellers, motivated by the desire to easily, efficiently and inexpensively connecting prospective buyers of goods and services with qualified sellers (Dahod, Col. 1, ll. 60-63). .

Re. Claim 14, Dahod discloses a computer system wherein the server engine is further configured to enable anonymous communication between proposal generators and

proposal receivers (Col. 2, ll. 27-29, 50-52, 55-56; Claims 34 & 63 – Col. 9, l. 18; Col. 11, l. 4).

Re. Claim 15, Dahod discloses a computer system wherein the business database contains data regarding real estate (Fig. 7), and a server engine which comprises a web server (Col. 4, ll. 6-46). Neither Dahod nor Wilkins explicitly disclose the session identifiers are session cookies, and the device identifiers are permanent cookies. However, the examiner takes Official Notice that the use of cookies as session identifiers and session cookies, and permanent cookies as device identifiers were well known in the art at the time of Applicant's invention, as disclosed by Wilkins. Accordingly it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have Official Notice regarding the well known uses of cookies to the art of Dahod and Wilkins, motivated by the purpose of easily, efficiently and inexpensively connecting prospective buyers of goods and services with qualified sellers (Dahod, Col. 1, ll. 60-63).

2. Claims 2, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahod and Wilkins as applied to claims 1, 9 and 16 above, and further in view of Liu et al. (US Patent 6,574,608, hereafter Liu).

Re. Claims 2, 11 & 17, Dahod discloses a method, system and computer readable medium of search information which is disclosed to the seller on a schedule chosen by the buyer (Col. 2, ll. 53-59). Neither Dahod nor Wilkins explicitly disclose the disclosing to a seller information which also corresponds to post-search browsing activity data. However, Liu discloses the gathering a series of online browsing data from a user over time to identify the on-going interests and potential changes and expansion in interests as demonstrated by browsing activity (Col. 1, l. 58 – Col. 2, l. 4; Col. 2, ll. 14-33; col. 8, l. 56 - Col. 9, l. 20). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Dahod and Wilkins with that of Liu to enable an anonymous online user prospect to authorize the release of post-search browsing activity by the middle man entity to the seller business expert in order

to capture valuable information regarding the changes in a user's interests over time (Liu, Col. 2, ll. 8-10).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dahod and Wilkins as applied to claim 1 above, and further in view of Walker et al. (US Patent 5,794,207, hereafter Walker207).

Re. Claim 4, Dahod discloses a method comprising transmitting a notification to a business expert of a new prospect (Col. 2, ll. 22-25, 37-41).

Neither Dahod nor Wilkins explicitly disclose maintaining a tracking status of a proposal. However, Walker discloses a method of tracking the status of buyer proposals in an anonymous system. It would have been obvious for an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Davod and Wilkins with that of Walker207 for the purpose of tracking the status of a proposal between a seller expert and an anonymous prospect in order to utilize the services the services of a trusted third party (Walker207, Col. 7, ll. 13-15).

4. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahod in view of Walker (US Patent 2002/0169626 A1, hereafter Walker626).

Re. Claim 21, Dahod discloses a computer-implemented method for anonymously connecting sales agents with consumers of housing, comprising:

(a) providing a software application designed to communicate with a database containing information regarding housing, wherein the software application is accessible via a computer network and enables searching of the database, whereby search criteria is stored in association with search-requestor information (Fig. 7); and

(b) wherein the software application generates prospects from the search criteria for viewing, and the software application enables generation of search-requestor-directed proposals based upon the prospects without revealing contact information for the search-requestor (Col. 2, ll. 27-29, 50-52, 55-56; Claims 34 & 63 – Col. 9, l. 18; Col. 11, l. 4).

Dahod does not explicitly disclose not requiring user registration but does disclose embodiments which do require registration. However, Walker626 discloses the connecting of consumers with merchants and sales agents of various kinds without requiring the consumer to register (Fig. 1-15; Page 1-15. Registration of consumers is absent in Walker. Walker only requires sellers, agents and reference providers to register.). Further, as demonstrated in the rejection of claims 1, 9 and 16, the teaching or suggestion by Dahod of seller prospect registration is optional and moot, as described in the rejection of claims 1, 9 and 16, since the facilitating server automatically is presented with the electronic device identity information of all devices which contact the facilitating server so that explicit registration is really optional and unnecessary for accomplishing Applicant's invention. Accordingly, it would have been obvious for an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Davod with that of Walker626 for the purpose of anonymously connecting sales agents with consumers of housing in order to provide a prospective customer with a good sales agent (Walker626, Page 1, [0003], ll. 1-2).

Re. Claim 22, Dahod discloses a computer-implemented method wherein the software application further enables anonymous communication between a proposal-creator and a proposal-receiver (Col. 2, ll. 49-51).

Re. Claim 23, Dahod discloses a computer-implemented method wherein the information regarding housing includes information regarding real estate for sale, information regarding common interest developments such as condominiums and coops, information regarding apartments for rent and a category for miscellaneous real estate available. Dahod does not explicitly disclose the provision of information regarding factory built homes. However, the examiner takes Official Notice that the marketing of factory built homes is well known. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Dahod with Official Notice regarding the well known information that factory built homes for sale are included in real estate housing listings for sale since factory built homes comprise a small subsegment of homes for sale as part of an anonymous system, motivated by the desire for easily, efficiently and

inexpensively connecting prospective buyers of goods and services with qualified sellers (Dahod, Col. 1, ll. 60-63).

5. **Claims 24 and 25 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Dahod in view of Walker626 as applied to claim 21, and further in view of Flight et al. (US Patent 6,662,199 B1, hereafter Flight).

Re. Claims 24 & 25, neither Dahod nor Walker626 explicitly disclose

- **Re. Claim 24**, a computer-implemented method wherein the software application comprises:
 - (a) a presentation layer;
 - (b) a middle layer, having business rule implementation objects, communications objects and database messaging objects; and
 - (c) a database.
- **Re. Claim 25**, Dahod discloses computer-implemented method wherein the database messaging objects include objects for translating XML data into a database-specific format.

However Flight discloses

- **Re. Claim 24**, a computer-implemented method wherein the software application comprises:
 - (a) a presentation layer;
 - (b) a middle layer, having business rule implementation objects, communications objects and database messaging objects; and
 - (c) a database.

(Abstract, Fig. 5, Col. 3, l. 51 – Col. 4, l. 63)

- **Re. Claim 25**, a computer-implemented method wherein the database messaging objects include objects for translating XML data into a database-specific format (Col. 10, l. 52; Col. 15, l. 15; Col. 18, claim 24).

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Dahod and Walker 626 with the art of Flight to

provide software which uses a simplified technique to more easily, efficiently and inexpensively connect qualified housing sales agents with customers (Flight, Col. 3, ll. ll. 1-48).

(10) Response to Argument

ARGUMENT A:

"Appellant's Claim 21 Is Directed To Statutory Subject Matter" (p. 9, l. 22 - p. 10, l. 15).

RESPONSE A

This rejection is withdrawn.

ARGUMENT B:

"Appellant's Claims 1 and 9 Do Not Fail To Comply With The Written Description Requirement" (p. 10, l. 16 - p. 12, l. 15).

RESPONSE B

This rejection is withdrawn.

ARGUMENT C:

"Appellant's Claims 1 and 9 Are Not Incomplete For Omitting Essential Steps" (p. 12, l. 16 - p. 13, l. 15).

RESPONSE C

This rejection is withdrawn.

ARGUMENT D:

'Appellant's Claims 1, 9 and 16 Do Not Lack Antecedent Basis For The "transmitting said proposal" Step' (p. 13, l. 16 - p. 14, l. 4).

'Appellant's Claims 1, 9 and 16 Do Not Lack Antecedent Basis For "anonymously submitted database search criteria"' (p. 14, ll. 5-15)

RESPONSE D

This rejection is withdrawn.

ARGUMENT E:

Primary Argument: Appellant's Claims 1, 3, 5-9, 10, 12-16 and 18-20 Are Not Obvious Over Dahod et al. in view of Wilkins et al.' (p. 14, l. 16 – p. 17, l. 7).

Sub-Argument 1: "..., independent claims 1, 9 and 16 of the present application are not obvious over Dahod et al. in view of Wilkins et al., and the Patent Office's rejection should be withdrawn." (p. 14, l. 18 – p. 17, l. 3).

(a) Special anonymity criteria described in the specification are not taught by Dahod (p. 15, ll. 11-18).

(b) "It makes no sense to combine Dahod et. al. and Wilkins et. al., as suggested by the Patent Office, to include the cookies disclosed by Wilkins et. al." (p. 15, l. 18 – p. 16, l. 3).

(c) The Patent Office overlooks the requirement of anonymity in combining Dahod and the cookie in Wilkins (p. 16, ll. 4-7).

(d) Dahod and Wilkins "teach away from the anonymous lead generation system claimed in the present invention" (p. 16, ll. 7-17).

Sub-Argument 2: "Claims 2-8, 10-15 and 17-20 depend from independent claims 1, 9 and 16 respectively. Since those independent claims are allowable for the reasons discussed above, the corresponding dependent claims are also allowable, and the examiner's rejection should be overturned." (p. 17, ll. 5-7).

RESPONSE E

Sub-Argument 1

(a) The anonymity criteria argued by Appellant are not claimed, making this argument moot.

(b) Combination of specific method steps from a plurality of references in business methods only combines the specific steps and does not drag with it any other component of the references because they are not needed for Appellant's invention and are not needed in making use of the specific tasks in the limitation. The reason is that there is no technical reason for the other components to come with the narrow teaching(s) used by the examiner in the rejection(s). When such tie ins exist they are

scientific phenomena where a broader chain of things has to be taken together because there is no known way of separating the elements, such as those of certain chemical reactions (see the case law reference cited below for the “teaching away” argument)..

(c) First, per MPEP 714.02, Appellant’s argument is moot since Appellant has merely made an assertion without providing the combination of evidence and rationale required for a valid traversal.

Second, the rejections have not overlooked the requirement for anonymity in the claimed invention because anonymity is presented in the prior art in the above rejections of claims 1, 9 and 16.

(d) Re. the “Teaching Away” Argument

First, per MPEP 714.02, Appellant’s argument is moot since Appellant has merely made an assertion without providing the combination of evidence and rationale required for a valid traversal.

Second, the rationale in the response to subargument 1(b) above also applies to the teaching away argument in the instant case. The Examiner is fully aware of the guidelines concerning this argument. The MPEP gives guidelines for teaching away in **MPEP § 2141.02** (prior art must be considered in its entirety, including disclosures that teach away from the claims) and **MPEP § 2143.01** (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference).

Case law offers further guidance on the issue of teaching away, in sum stating that the Nature of the Teaching Is Highly Relevant, as expressed in the court’s opinions in *W.L. Gore & Associates v. Garlock, Inc.*, and in *In re Gurley*, as follows:

(a) *W.L. Gore & Associates v. Garlock, Inc.* This (case) involves a teaching of “stretching said (unsintered) PTFE at a 10% per second rate to more than five times the original length. A reference teaching rapid stretching of conventional plastic polypropylene with reduced crystallinity combined with a reference teaching plastic stretching unsintered PTFE, would not have suggested rapid stretching of highly crystalline PTFE, in light of the disclosures in the art that teach away from the invention, i.e., that the conventional polypropylene should have reduced crystallinity before stretching, and that PTFE should be stretched slowly”.

Having read this court opinion, the examiner concludes that the relevant aspect of the opinion turned on the court's finding that a technical error had been argued in the justification of an obviousness combination of two teachings. The court finding of a technical distinction in this case could not be clearer. The court found that the combination of the properties of two unrelated polymers was technically incompatible and thus the teachings could not be properly combined. Thus the court followed common sense logic.

(b) The *In re Gurley* opinion offers further guidance on the issue of teaching away, in sum stating that the Nature of the Teaching Is Highly Relevant, as follows: A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for applicant's purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.).

To summarize, these two court opinions demonstrate that the concept of "teaching away" has technical foundations and requirements of a limited, narrow technical nature of a common sense variety.

In this case, It becomes clear that, contrary to Appellant's assertion, trends not cited in the reference as teaching away in a manner relevant to the specific use of the Dahod's disclosures from being modified to meet Appellant's limitations.

Response to Sub-Argument 2:

Since independent claims 1, 9 and 16 are not allowable as explained above dependent claims 2-8, 10-15 and 17-20 are not allowable.

ARGUMENT F:

"Appellant's Claims 2, 11 and 17 Are Not Obvious Over Dahod et al. and Wilkins et al. and Further In View of Liu" (p. 17, ll. 8-19).

RESPONSE F

Since independent claims 1, 9 and 16 are not allowable as explained above dependent claims 2, 11 and 17 are not allowable.

ARGUMENT G:

"Appellant's Claim 4 Is Not Obvious Over Dahod et al. and Wilkins et al. and Further in View Of Walker et al." (p. 17, l. 20 – p. 18, l. 5).

RESPONSE G

Since independent claim 1 is not allowable as explained above dependent claim 4 is not allowable.

ARGUMENT H:

"Appellant's Claim 21 Is Not Obvious Over Dahod et al. in view of Walker et al. " (p. 18, l. 6 – p. 19, l. 21).

Sub-Argument 1 - Teaching Away by Dahod and Walker. (p. 18, l. 9 – p. 19, 2).

Sub-Argument 2 - "Neither Dahod et al. nor Walker et al., nor their combination, make any teaching, suggestion, or disclosure of storing such search criteria." (p. 19, ll. 3-11).

Sub-Argument 3 - "Lastly, since neither Dahod et al. nor Walker et al. alone discloses storing search criteria without a requirement of user registration, Dahod et al. and Walker et al. can not in combination teach every limitation of the rejected claim 21."(p. 19, ll. 12-17).

RESPONSE H

Sub-Argument 1 - The same criteria which invalidate a Teaching Away argument in argument E 1 (d) above apply here.

Sub-Argument 2 -

First, per MPEP 714.02, Appellant's argument is moot since Appellant has merely made an assertion without providing the combination of evidence and rationale required for a valid traversal.

Second, Dahod does indeed teach the "storing search criteria in association with search-requester information". This is implicit in Fig. 7, since the searching user could

not obtain valid results without such stored association of search criteria. The counter party's response could not find itself back to the party which had posted the offer to sell or the interest in buying a given product or service. Further, storage of search criteria in association with search-requester information is essential in col. 2, ll. 30-45. Dahod's system could not function without such information storage. The database is explicitly disclosed in Col. 2, l. 20 as part of a more detailed description of the information posting process of search criteria by prospective buyers.

Sub-Argument 3 -

First, Dahod does indeed disclose storing search criteria without a requirement of user registration, Dahod et al. and Walker et al. can not in combination teach every limitation of the rejected claim 21."(p. 19, ll. 12-17).

Second, Appellant makes a bold assertion regarding the lack of a teaching in either Dahod or Walker of "storing search criteria without a requirement of user registration" without offering any combination of evidence and sufficient rationale for a proper traversal, as required by MPEP 714.02.

Third, the above rejection of claim 21 does indeed show that Walker discloses "storing search criteria without a requirement of user registration" (Walker, Fig. 1-15; Page 1-15. Registration of consumers is absent in Walker. Walker only requires sellers, agents and reference providers to register.).

Fourth, the guidelines for a proper *prima facie* case of obviousness *In re Kahn* do not require that the references "in combination teach every limitation" of a claim. Also included is what the ordinary practitioner at the time of Appellant's invention would have seen as obvious in combination with prior art.

"The Court noted that "[t]o facilitate review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 1741, 82

USPQ2d at 1396.” (The court referred to in this case is the US Supreme Court in the KSR decision of April, 2007). Therefore, in the instant case, Appellant’s argument that “since neither Dahod et al. nor Walker et al. alone discloses storing search criteria without a requirement of user registration, Dahod et al. and Walker et al. can not in combination teach every limitation of the rejected claim 21” is without merit.

In summary, based on the guidelines in KSR and In re Kahn, since Appellant’s arguments are without merit, and since the examiner has met the requirements of these court guidelines, the examiner has provided a proper *prima facie* case of obviousness in the rejection of independent claim 21.

ARGUMENT I:

“Appellant’s Claims 24 and 25 Are Not Obvious Over Dahod et al. in View of Walker et al. and Further In View Of Flight et al.” (p. 19, l. 22 – p. 20, l. 9).

RESPONSE I

Since independent claim 21 is not allowable as explained above dependent claims 24 and 25 are not allowable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Siegfried E. Chencinski

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